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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUTOYO MAEHIRO

Appeal 2008-0459
Application 09/820,554¹
Technology Center 2100

Decided: July 9, 2008

Before HOWARD B. BLANKENSHIP, JEAN R. HOMERE, and
JAY P. LUCAS, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1 through 13, 15 through 28, and 30. Claims 14, 29, and 31 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ Filed on March 29, 2001. The real party in interest is Kabushiki Kaisha Square Enix (also trading as Enix Square Co., LTD.)

The Invention

Appellant invented a method and system for allowing a group of users to retrieve membership information from a profile server. (Spec. 3-4.) As depicted in Figure 1, a storage device within the profile server (115) stores the membership information for each registered user including the username, profile, and video game status information. Upon receiving from a group of terminals (103, 104) a request to retrieve membership information, the profile server compares a condition within the request with the membership information in the storage device to locate the requested membership information, which it forwards to the requesting terminals. (Spec. 18-20.)

Exemplary claims 1, 5, and 13 further illustrate the invention. They read as follows:

1. A membership information retrieval server for retrieving membership information by accepting at least one retrieval condition from a group of user terminals, comprising:

a storage device for receiving the membership information from a group of users and storing the membership information, the membership information comprising user-entered text messages that are dynamically updated by the users and the membership information further comprising dynamically updated video game status information;

a retrieval system that compares the at least one retrieval condition with the user-entered information and extracts selected membership information from the storage device; and

a communications system that sends the membership information extracted by the retrieval system to the user terminals from which the at least one retrieval condition are sent.

5. The membership information retrieval server as claimed in claim 2, wherein membership information stored in the storage device is updated based on user input when one of the users desires to update as a result of changed circumstances.

13. A user terminal for accessing the membership information retrieval server as claimed in claim 1, comprising:

a first sending system that enters at least one retrieval condition and sends the at least one retrieval condition to the retrieval server,

a display that displays the membership information sent from the retrieval server;

a creation system that accepts selection of a plurality of members from the members in the membership information displayed by the display and creates a temporary user list that includes membership information about the plurality of selected members;

a first acceptance system that accepts entry of a message to be sent to user terminals to be used by the plurality of members listed in the temporary user list; and

a second sending system that sends the message accepted by the first acceptance system to the user terminals.

In rejecting the claims on appeal, the Examiner relies upon the following prior art:

Junkin	US 6,193,610 B1	Feb. 27, 2001
MacNaughton	US 6,433,795 B1	Aug. 13, 2002
		(filed Dec. 7, 1999)

The Examiner rejected the claims on appeal as follows:

Claims 1 through 13, 15 through 28, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of MacNaughton and Junkin.

FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

MacNaughton

1. MacNaughton discloses an interactive online community for allowing registered members to remotely socialize with one another. (Col. 3, ll. 15-29.)

2. As depicted in Figure 1, the online community includes a community web browser (10) for permitting community members to provide membership information including changes to a webpage, and to submit requests to a community server (18). (Col. 6, ll. 6-28, ll. 42-50.)

3a. A membership profile for each registered member is generated to include the member's name, address, age, billing information, interests, and hobbies. The generated profiles are stored in the membership database (44). (Col. 8, ll. 28-37.)

3b. A member can have a different profile for each community to which he/she belongs. In fact, MacNaughton discloses creating a new membership profile for a user each time he/she joins a new community. This suggests that such new profile is added to the membership database, thereby updating the database. The member can also cancel or change

his/her membership to a community, which will cause the member's profile information for that community to be deleted from the membership database (44). (Col. 8, ll. 37-43.)

4a. A community member can send a request to the community server to retrieve a list of other members that are currently online. The member can also send an invitation to online members to chat, and to play games. (Col. 7, ll. 1-17, col. 9, ll. 32-41.)

4b. The community member can list the members currently participating in a community. The member can then access their profile data to modify a personal member profile. The community member can subsequently search the community membership including the members' profiles. (Col. 9, ll. 41-45.)

5. A community toolbar appears on the browser of the member's computer as an interface to enable the member to control the community and to interact with fellow members (e.g. in an on-line game). (Col. 10, ll. 1-16, col. 23, l. 66 - col. 24, l. 3.)

Junkin

6. Junkin discloses an interactive television system for enabling a TV viewer to compete in a broadcast sporting event. The interactive broadcast event includes a ticker tape that provides up-to-date real time score values about the performance of the players. (Abstract, col. 9, ll. 18-25.)

PRINCIPLES OF LAW
OBVIOUSNESS

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir.

2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’”

KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739(2007)). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 127 S. Ct. at 1742.

Discussing the obviousness of claimed combinations of elements of prior art, *KSR* explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* [v. *AG Pro, Inc.*, 425 U.S. 273 (1976)] and *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740. Where the claimed subject matter cannot be fairly characterized as involving “the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement,” a holding of obviousness can be based on a showing that “there was an apparent reason to combine the known elements in the fashion claimed.” *KSR*, 127 S. Ct. at 1740-41. Such a showing requires “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, 127 S. Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

The reasoning given as support for the conclusion of obviousness can be based on “interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art”. *KSR*, 127 S. Ct. at 1740-41. See also *Dystar Textilfarben GmbH &*

Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1368 (Fed. Cir. 2007).

We note our reviewing court has recently reaffirmed that:

[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the ‘improvement’ is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal—and even common-sensical—we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.

Leapfrog, 485 F.3d at 1162 (holding it “obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost”).

Also, a reference may suggest a solution to a problem it was not designed to solve and thus does not discuss. *KSR*, 127 S. Ct. at 1742 (“Common sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. . . . A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

The prior art relied on to prove obviousness must be analogous art. As explained in *Kahn*,

the ‘analogous art’ test . . . has long been part of the primary Graham analysis articulated by the Supreme Court. *See Dann* [v. *Johnston*,] 425 U.S. [219,] 227-29 [1976], *Graham*, 383 U.S. at 35.... The analogous-art test requires that the Board show that a reference is either in the field of the applicant’s endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*[, at 1447]. References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality of the circumstances,’—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” (quoting *In re Wood*, 599 F.2d 1032...(C.C.P.A. 1979))).

Kahn, 441 F.3d at 986-87. *See also In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (“[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”).

In view of KSR’s holding that “*any* need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed,” 127 S. Ct. at 1742 (emphasis added), it is clear that the second part of the analogous-art test as stated in *Clay*, *supra*, must be expanded to require a determination of whether the reference, even though it may be in a different field from that of the inventor’s endeavor, is one which, because of the matter with which it deals, logically would have commended itself to an artisan’s (not necessarily the inventor’s) attention in considering *any* need or problem known in the field of endeavor. Furthermore, although under *KSR*

it is not always necessary to identify a known need or problem as a motivation for modifying or combining the prior art, it is nevertheless always necessary that the prior art relied on to prove obviousness be analogous. *See KSR*, 127 S. Ct. at 1739. (“The Court [in *United States v. Adams*, 383 U.S. 39, 40 (1966)] recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another *known in the field*, the combination must do more than yield a predictable result.”) (emphasis added). *See also Sakraida*, 425 U.S. at 280:

(“Our independent examination of that evidence persuades us of its sufficiency to support the District Court's finding ‘as a fact that each and all of the component parts of this patent . . . were old and well-known throughout the dairy industry long prior to the date of the filing of the application for the Gribble patent.’”).

ANALYSIS

Claims 1, 15, 16, and 30

Independent claims 1, 15, 16, and 30, recite in relevant part extracting selected membership information including user-entered text messages that are dynamically updated by the users. (Claims Appendix.) Appellant argues that the combination of MacNaughton and Junkin does not teach these limitations. Particularly, Appellant submits that MacNaughton discloses the one-time event of collecting membership information and canceling the membership to delete the corresponding profile. However, it does not search dynamically updated user entered membership information. (App. Br. 14-16, Reply Br. 6-7.) Further, Appellant argues that MacNaughton and Junkin are not properly combinable because they are not analogous art. (App. Br.

10-11, Reply Br. 3.) Additionally, Appellant argues that there is insufficient rationale for combining the teachings of MacNaughton with Junkin's. (App. Br. 11, Reply Br. 3-4.) The Examiner, in response, avers that MacNaughton's teaching of canceling a community membership, which causes a corresponding profile to be deleted from the membership database teaches or suggests that the database has been updated. (Ans. 13.) Further, the Examiner finds that Junkin complements MacNaughton by particularly providing it with the ability to display real-time video game status. (Ans. 8.)

Therefore, the pivotal issue before us is whether one of ordinary skill in the art would have found sufficient rationale for combining the teachings of MacNaughton with Junkin's to yield extracting selected membership information including user-entered text messages that are dynamically updated by the user, as claimed. We answer this inquiry in the affirmative.

As detailed in the Findings of Facts section above, MacNaughton discloses canceling a community membership to thereby delete a corresponding member profile from the membership database. (FF. 3b.) We agree with the Examiner that by deleting a selected member's profile from the membership database, MacNaughton teaches modifying the data in the database thereby updating the membership information in the database. Therefore, one of ordinary skill in the art would readily recognize that MacNaughton's search of the membership database subsequently to deleting the selected profile from the database teaches or suggests searching updated membership information in the database. We do not agree with Appellant that such update of the database is a single event, which does not rise to a dynamic update. The ordinarily skilled artisan would have appreciated that in an on-line community such as MacNaughton's, new members are

constantly being added while existing members are continuously canceling their membership. Therefore, the ordinarily skilled artisan would have readily appreciated the membership database would need to be dynamically updated to accurately reflect the current state of in the community membership.

Further, MacNaughton explicitly discloses modifying a selected profile retrieved from a list of the members currently participating in a community, and subsequently searching the community membership including the modified profile. (FF. 4b.) The ordinarily skilled artisan would have similarly appreciated that MacNaughton's subsequent search of the membership information including the modified profile data would predictably result in extracting selected membership information from the updated data in the membership database.

Additionally, as detailed in the Findings of Fact section above, Junkin teaches an interactive TV system for enabling a viewer to keep track in real-time of scores of each player while competing in a broadcast sporting event. (FF. 6.) The ordinarily skilled artisan would have readily appreciated that Junkin is analogous art since it pertains to Appellant's field of endeavor of on-line gaming, and it reasonably pertains to solving the problem of providing the real time status of each player. Consequently, Junkin's teaching real-time status of each contestant in a sporting event taken in combination with MacNaughton's on-line game, would *predictably result* in a system that an online gaming wherein each community member can obtain in real-time the score of each player. Therefore, Appellant's allegation that there is insufficient rationale to combine the cited references is not persuasive. The Supreme Court has held that in analyzing the obviousness

of combining elements, a court need not find specific teachings, but rather may consider "the background knowledge possessed by a person having ordinary skill in the art" and "the inferences and creative steps that a person of ordinary skill in the art would employ." *See KSR Int'l*, at 1740-41. To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* at 1740. As set forth above, dynamically updating membership information in a database is a prior art element that is being used for the known purpose of allowing retrieved membership information to be current and relevant.

It therefore follows that Appellant has not shown that the Examiner erred in concluding that the combination of MacNaughton and Junkin renders independent claims 1, 15, 16, and 30 unpatentable.

Claims 13, 15, 28, and 30

Appellant argues that the combination of MacNaughton and Junkin does not teach accepting selection of a plurality of members, and creating a temporary user list that includes membership information about a plurality of selected members. (App. Br. 16.) We do not agree. As detailed in the Findings of Facts section above, MacNaughton discloses displaying on the user's toolbar screen a list of members currently participating in a community. (FF. 4b, 5.) MacNaughton further discloses that the user can access selected profile data. (*Id.*) One of ordinary skill in the art would have readily recognized that upon selecting the profile data of at least two members for viewing, the user would in essence create a temporary list of member profiles for viewing. It therefore follows that Appellant has not shown that the Examiner erred in concluding that the combination of MacNaughton and Junkin renders claims 13, 15, 28, and 30 unpatentable.

Claims 5, 8, 11, 12, 20, 23, and 26

Appellant argues that the combination of MacNaughton and Junkin does not teach membership information stored in the storage device is updated based on user input when one of the users desires to update as a result of changed circumstances. (App. Br. 18.) We do not agree. As detailed in our discussion of independent claims above, MacNaughton teaches modifying membership data in the membership database when new users have joined a community or existing users have left the community to accurately reflect the state of the community. One of ordinary skill in the art would readily recognize that adding or removing members' profiles from the membership database indicates changed circumstances in the community that need to be captured in the database. It therefore follows that Appellant has not shown that the Examiner erred in concluding that the combination of MacNaughton and Junkin renders dependent claims 5, 8, 11, 12, 20, 23, and 26 unpatentable.

Appellant does not provide separate arguments with respect to the rejection of claims 2 through 4, 6, 7, 9, 10, 17 through 19, 21, 22, 24, 25, and 27. Therefore, we select claims 1, 5, and 13 as being representative of the cited claims. Consequently, claims 2 through 4, 6, 7, 9, 10, 17 through 19, 21, 22, 24, 25, and 27 fall together with representative claims 1, 5, and 13. 37 C.F.R. § 41.37(c)(1)(vii).

SUMMARY and DECISION

Appellant has not shown that the Examiner erred in concluding that the combination of MacNaughton and Junkin renders claims 1 through 13, 15 through 28, and 30 unpatentable under 35 U.S.C. § 103(a). We therefore affirm the Examiner's rejection of these claims.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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